

REMARKS

Claims 1 through 14 are pending in this Application. Applicants acknowledge, with appreciation, the Examiner's indication that claims 2 through 8, 10, and 11 contain allowable subject matter.

Claims 2 and 10 have been amended by placing them in independent form and in condition for allowance. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1, 9, and 12 through 14 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon Miyake et al. ("Miyake") in view of Endo et al. ("Endo").

In the statement of the rejection the Examiner initially declined to give weight to the claim limitation "for being applied to coat a photoresist film when using an immersion exposure device which is irradiated through water provided between a lens and a photoresist film...being dissolved in a subsequent developer." In apparent recognition of the weakness of this position, the Examiner asserted that one having ordinary skill in the art would have been led to employ "immersion exposure in the composition of Miyake because immersion exposure is well known to improve resolution of the pattern" apparently relying on Endo. This rejection is traversed.

Initially, it is legally erroneous to ignore the claim limitation "for being applied to coat a photoresist film when using an immersion exposure device which is irradiated through water provided between a lens and a photoresist film...being dissolved in a subsequent developer." As stated by the Court of Appeals for the Federal Circuit in *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997): "A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 58 C.C.P.A. 1027, 439 F.2d 210, 212, 169 USPQ 226, 228

(CCPA 1971) (“[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.”).” The Examiner has offered no basis upon which to predicate the determination that the composition disclosed by Miyake is even capable of being applied to coat a photoresist film when using an immersion exposure device which is irradiated through water provided between a lens and a photoresist film...being dissolved in a subsequent developer,” as specified in independent claim 1, and no such basis is apparent.

The Examiner’s fallback position that that one having ordinary skill in the art would have been led to employ “immersion exposure in the composition of Miyake because immersion exposure is well known to improve resolution of the pattern” lacks the requisite factual basis. What may or may not be known in general (a “nothing new under the sun” approach) does not provide the requisite basis to modify a particular reference in a particular manner to arrive at a particularly claimed invention. *In re Newell*, 873 F.2d 899 (Fed. Cir. 1989).

To whatever extent the Examiner has relied upon Endo for the requisite motivation, any such reliance is misplaced. As apparent and not disputed on the record, Miyake neither discloses nor suggests forming a pattern by immersion exposure with water. However, it is apparent that in Endo, the relied upon immersion lithography is performed using a **nonaqueous solution. Water is not used.** This is because in Endo the topcoat is a water-soluble film (see paragraph [0034]). It is therefore apparent that even if the applied references were combined as proposed by the Examiner, and Applicants certainly do not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of 1, 9, and 12 through 14 under 35 U.S.C. §103(a) for obviousness predicated upon Miyake in view of Endo is not factually or legally viable and, hence, solicit withdrawal thereof.

Claim Objections.

The Examiner objected to claims 2 through 8, 10, and 11 as dependent on a rejected base claim, but indicated that they would be allowable if presented in independent form. As claims 2 and 10 have been placed in independent form this objection has been overcome and claims 2 through 8, 10, and 11 are in clear condition for allowance.

Based upon the foregoing, it is apparent that the imposed objection and rejection have been overcome, and that all pending claims are in condition for allowance. Favorable consideration is therefore solicited. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-519-9954 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

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Date

/Arthur J. Steiner/

Arthur J. Steiner

Attorney/Agent for Applicant(s)

Reg. No. 26106

918 Prince Street
Alexandria, VA 22314
Tel. (703) 519-9951
Fax (703) 519-9958